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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,749	06/09/1999	JEFFREY E. GEBHARD	ADI-005	7235

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GOODWIN PROCTER LLP  
PATENT ADMINISTRATOR  
EXCHANGE PLACE  
BOSTON, MA 02109-2881

EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/328,749

Applicant(s)

GEBHARD, JEFFREY E.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-21 and 23-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4,6-21 and 23-26 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 09 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Response To Board of Appeals and Interferences Decision**

1. Appellant's response to the BPAI decision on October 31, 2005 and new rejection under 37 CFR §41.50(b) has been entered and a response to that amendment follows. As noted in MPEP § 1214.04, "If the examiner has specific knowledge of the existences of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection." With this in mind, the examiner has noted that the Board decision did not reverse the examiner on the combination of the references previously used with respect to Anderie only. The Board only considered the combination of Anderie in view of Dubner and Kraeuter. Therefore, the examiner is aware of references that would indicate nonpatentability of the reversed claims and has entered such rejections below, thereby reopening the application for prosecution under 37 CFR 1.198.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 6, 8-13, 15, 17, 20-21, 24 26 are rejected under U.S.C. 5 102(b) as being anticipated by Anderie 4,922,631. More particularly, we point to the embodiment seen in Figures 4-10 of Anderie and find that the intermediate sole member (101) constitutes a "torsion system" like that defined in appellant's claims 1, 9, 15, 20 and 26 on appeal, while the wearing or outsole (102) provides response for the inferentially recited shoe "sole with a forefoot area and a rearfoot area" in those claims. In that regard, we

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note that the sports shoe bottom described in Anderie and shown in Figures 9 and 10 appears to include an outer wearing sole (102) having a forefoot area (103) and a rearfoot area (104), as well as a “torsion system” comprised of the intermediate sole member (101) which includes a forefoot portion spanning substantially the entire forefoot area of the outer wearing sole, with the forefoot portion having a generally smooth concave contour along the longitudinal axis thereof (Fig. 10); a rearfoot portion spanning substantially the entire rearfoot area of the outer wearing sole; and an intermediate portion (including central limb 108 and stiffening element 109 embedded therein) coupling the forefoot portion and the rearfoot portion of the torsion system, and constructed of a material and configured to allow, in a pre-selected manner, rotation of the forefoot relative to portion rearfoot portion about the longitudinal axis (see, col.7, lines 15-19), and wherein the intermediate portion includes a rib (e.g., 114, 115, or 116) that projects beyond an adjacent surface (e.g., 113, 118 or 119) of the tension system. Contrary to appellant's arguments in the brief and reply briefs, it appears to us that the language of claim 26 on appeal with regard to the rib projecting beyond “an adjacent surface of the torsion system” (emphasis added) does not require the rib project beyond all surfaces of the torsion system, as appellant seems to believe, but only requires that the rib project beyond some “adjacent surface” of the torsion system. This is particularly true, since the rib as set forth in independent claims 1 and 26 is clearly recited as being part of the torsion system, not as being an element separate from the torsion system, as appellant's arguments seem to imply.

Concerning claims 15 and 20, we note that the intermediate sole member (101) defining the “torsion system” of the shoe sole seen in Anderie includes a forefoot portion, rearfoot portion and an intermediate portion that together form a single plate and wherein a width of the intermediate portion of the plate is narrower than the forefoot and rearfoot portions (Fig. 9) and the material properties of the foamed plastic forefoot and rearfoot portions are different than the intermediate portion including the hard polyamide stiffening element (109).

Furthermore, the limitation in claim 1 that “the intermediate portion includes a rib that projects beyond a bottom most surface of the torsion system” fails to overcome the rejection as set forth. As seen in Figure 10 of Anderie and described by the Board of Appeals, the bottom most surface of the “torsion system” would be the bottom surface of 101. The ribs of section 109, that is embedded in 101, would project beyond, i.e. above, the bottom most surface of 101, the torsion system. Therefore, appellant’s amendment fails to overcome the rejection set forth by the Board of Appeals.

Anderie ‘631 also includes the following limitations of claims 6, 8, 10-13, 17, 19, 21, 24 and 26: the rib tunes the torsionability of the article of footwear (see col. 5, lines 62-66), the rearfoot portion defines at least one aperture 120; the plate is substantially rigid in the a horizontal plane (see col. 5, lines 1-8 and 53-66); the plate is between about 1-15, 3-10 or 5-8 millimeters thick (see col. 5, lines 42-44); the plate comprises a composite material (see col. 8, lines 25-45); sole with a sole plate rigid in horizontal plane and including a longitudinal axis (see combination of 101 and 109 as denoted by the Board of Appeals in relation to the “torsion system” denoted above); the rib that projects beyond an adjacent surface of the sole plate (see Figure 6, parts 114, 115, 116); an outsole 102.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderie 4,922,631 as applied to claim 21 in paragraph 3 above in view of Nagano et al. 5,446,977. Anderie ‘631 as applied to claim 21 in paragraph 3 above discloses all the limitations of the claims except for the footwear being a cycle shoe and having a cleat attachment. Nagano et al. teaches that it is desirable to

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have a torsion system placed within a cycle shoe, with a cleat attachment (8, 9a, 9), to keep the foot located properly on the pedal of a bicycle to allow for the largest driving force possible to be transferred from the user's leg to the pedal. Therefore, it would have been obvious to place the torsion system of Anderie '631 as applied to claim 21 in paragraph 3 above into a bicycle shoe, such as that shown in Nagano et al. '977, to aid in keeping the foot properly located on the pedal to get the most work out of the energy expelled by the rider and to help in correcting the twisting of the user's leg due to the pedaling of the bicycle. Nagano et al. '977 also shows the shoe containing an upper as seen in Figures 8-9.

6. Claims 2-4 and 11-14, and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Anderie '631 as applied to claims 1 and 9 in paragraph 3 above. Anderie '631 as applied to claims 1 and 9 in paragraph 3 above discloses all the limitations of the claims except for the specific degree of rotation of the forefoot portion to the rear foot portion, the thickness of the intermediate portion or the intermediate portion being made of graphite. It appears that it would have been a mere matter of testing and optimization to find the degree of rotation of the forefoot portion with respect to the rear foot portion that would best aid the foot to rotate the desired amount to counter the rotation of the foot due to knee movement. It also appears that it would have been a mere matter of testing and optimization to find the thickness and material makeup (as the material make up of the intermediate also is a factor in determining the necessary thickness needed) of the intermediate portion that would allow the desired rotation and to customized the torsion system to different people's feet. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to find the proper angle of rotation of the forefoot portion to the rear foot portion and the thickness and material of the intermediate portion that would best compensate for the twisting motion performed by the knee on the foot.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderie '631 as applied to claim 1 in paragraph 3 above in view of Eisenbach et al. 4,815,222. Anderie '631 as applied to claim 1 in paragraph 3 above discloses all the limitations of the claim except for the intermediate portion defining at

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least one circumscribed aperture. Eisenbach et al. '222 teaches that the intermediate portion of a sole of a bicycle shoe can have a circumscribed aperture (24 in Figure 5A) located therein to allow for adjustably mounting a cleat into any one of a number of positions on the shoe (see col. 4, lines 20-23). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place such an aperture in the sole of Anderie '631 as applied to claim 1 in paragraph 3 above to allow for a traction cleat to be mounted on the shoe if desired.

8. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being obvious over Anderie 4,922,631 as applied in paragraph 3 above. Anderie '631 discloses in the second embodiment of Figures 4-10, all the limitations of the claim except that the plate can be made of nylon. The first embodiment of Anderie '631 teaches that the stiffening element 9 can include wires 91 made of nylon (see col. 4, line 7) to form the flat strip of the anchoring element. Anderie further teaches that the mesh fibers of the inserts 92, 93 (118, 119 of the second embodiment is the equivalent of these) can be made of embedded glass fibers in the sole. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the strip 109 of Anderie out of nylon and the anchors out of fiberglass, as taught by the first embodiment of Anderie, to provide strength to the flat strip 109 especially in tension and provide the stiffening means for the inserts 118, 119.

### ***Response to Arguments***

9. Appellant's arguments filed December 23, 2005 have been fully considered but they are not persuasive. Appellant argues that the addition in claim 1 of the rib projecting beyond "a bottom most" surface of the torsion system overcomes the rejection set forth. As clearly pointed out in the rejection above, the only requirement is that the rib project beyond the bottom most surface of the torsion system 101 denoted in Figure 10. As shown, the ribs of the insert 109 would project beyond the bottom most surface of 101 as that insert is placed within 101 and the ribs are not in the same plane as the bottom most

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surface of 101. In arguendo, if the lowest point of the torsion member were the surface that the insert was resting on, for example in Figure 6 at the bottom of the figure would be the lowest surface, then 115, 116 and 114 project beyond this surface as they rise up therefrom. Furthermore, appellant argues that since claim 6 was not rejected, it was added to claim 26 and claim 26 is now allowable. The limitations of claim 6 and 26 are addressed in the reject with respect to Anderie set forth above.

### *Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

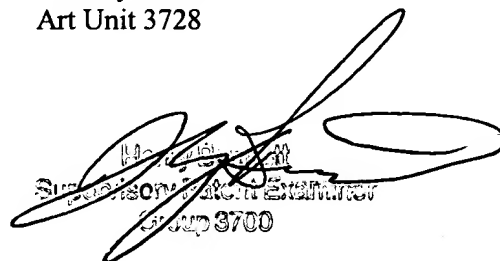
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS



Supervisor  
Art Unit 3700

ACTING DIRECTOR TC 3700